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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,000	01/16/2004	Jean Qiu		8672
32836	7590	08/23/2005		
GUERIN & RODRIGUEZ, LLP 5 MOUNT ROYAL AVENUE MOUNT ROYAL OFFICE PARK MARLBOROUGH, MA 01752			EXAMINER	AMARI, ALESSANDRO V
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/760,000	QIU, JEAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alessandro V. Amari	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6 and 15-17 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4,5,7-14 and 18-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I and species 2 (claims 4, 5, 7-14 and 18) in the reply filed on 16 August 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 2, 3, 6, and 15-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

### ***Claim Objections***

2. Claims 19 and 20 are objected to because of the following informalities:

In regard to claims 19 and 20, the method claims do not recite any active steps. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 5, 7-12, 14, 18, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blatt et al US 4,761,381 in view of Mitchell US 4,997,266.

In regard to claims 1, 19 and 20, Blatt et al teaches (see for example, Figs. 1-3) a unitary chamber for counting microscopic objects in liquid or a method of making a unitary chamber for counting microscopic objects in liquid or a method of counting

microscopic objects in liquid with a unitary chamber comprising a top part (2), a base part (4), a connecting layer (3), a sample introduction port (7), an air escape port (5) wherein said connecting layer is between said top part and said base part as shown in Figure 1 and wherein said connecting layer is at a pre-determined thickness as described in column 5, lines 15-45. Regarding claim 18, Blatt et al teaches (see Fig. 2) a plurality of unitary chambers (8, 11).

However, in regard to claims 1, 19 and 20, Blatt et al does not teach a counting grid.

In regard to claims 1, 19 and 20, Mitchell teaches (see Fig. 2, 3) a counting grid (19).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the counting grid of Mitchell in the chamber of Blatt et al in order to more accurately determine the concentration or counting and inspection of suspended particulate matter or other specimens.

Regarding claims 4 and 5, Mitchell teaches that the counting grid is an integral part of the base part and that the counting grid is on the top side of said bottom part as described in column 3, lines 48-65.

Regarding claims 7, 8 and 9, Mitchell teaches that said counting grid lines width range from 0.1 micrometer to 1mm as described in column 5, lines 1-2 and 27-29.

Regarding claims 10-12 and 14, Mitchell teaches the manufacture of the counting grid onto the top side of the base part as described in column 3, lines 60-68 and column 4, lines 1-56. Applicant should note that while the prior art does not teach manufacture

of the counting grid by way of radiation polymerizable solution as claimed, the claims are considered product-by-process claims and in product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blatt et al US 4,761,381 in view of Mitchell US 4,997,266 and further in view of Fisch US Re 35,589.

Regarding claim 13, Blatt et al in view of Mitchell teaches the invention as set forth above but does not teach that the counting grid is manufactured on the bottom side of the top part. Applicant should note that while the prior art does not teach manufacture of the counting grid by way of a polymerizable solution as claimed, the claims are considered product-by-process claims and in product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102/103 rejection [is] made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. This rejection under 35 U.S.C. 102/103 is proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 13, Fisch does teach (see Figs. 2a, 2b, 3a) that the counting grid (38) is on the bottom side (32) of the top part (3) as described in column 4, lines 4-11.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to put the counting grid on the bottom side of the top part as taught by Fisch for the chamber of Blatt et al in view of Mitchell so that the counting gird is more visible to the observer to provide more precision for determining the concentration or inspection of suspended particulate matter or other specimens.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*available*  
20 August 2005

Alessandro Amari  
Alessandro Amari  
Examiner AU 2872